Docket No.: 067339-0033 **PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Customer Number: 20277
Siu-lcong IU, et al.	:	Confirmation Number: 3640
Application No.: 09/763,917	:	Group Art Unit: 3685
Filed: July 03, 2001	:	Examiner: Winter, John M

For: WATERMARKING SYSTEM AND METHODOLOGY FOR DIGITAL MULTIMEDIA CONTENT

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Pre-Appeal Brief Request for Review is being filed in response to the final Office Action dated November 26, 2008. A Notice of Appeal is being filed concurrently herewith.

Claims 19-30 and 62-77 are pending in this application.

REMARKS

Claims 19-30 and 62-77 are patentable over Rhoads (USP No. 6,363,159), Saito (USP No. 6,182,218), Chaum (USP No. 5,959,717) and Official Notice.

The Examiner's Position:

The Examiner has rejected claims 19-30 and 62-77 under 35 U.S.C. § 103(a) as being unpatentable over Rhoads (USP No. 6,363,159) in view of Saito (USP No. 6,182,218) and further in view of Chaum (USP No. 5,959,717) and further in view of Official Notice.

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In the rejection of claims, 19-21, 23-30 and 62-77, the Examiner states that the language Appellant considers lacking from the prior art references is directed towards intended use ("will be distorted and the distortion of the composite video image can be seen by the viewer").

Moreover, the Examiner states that "Official Notice" is taken that the various warping techniques in claims 20, 21 and 23-30 are common and well known in the prior art. As such, the Examiner alleges these claims are not patentably distinct from claim 19 and are rejected for at least the same reasons. Furthermore, claims 62-77 are held to be not patentably distinct from claims 19-21 and 23-30 and as such are rejected for at least the same reasons. Thus, as claims 20, 21 and 23-30 are not patentably distinct from claim 19 and as claims 62-77 are not patentably distinct from claims 19-21 and 23-30, the Examiner has essentially declared all of claims 19-21, 23-30 and 62-77 as not patentably distinct from each other.

Appellants Position:

One aspect of claims 19-21, 23-30 and 62-77 is that they recite a:

> means for imparting a prescribed transformation to the video image for warping the video image in a manner, and by an amount, not readily visible to a viewer such that a composite video image produced by multiple video playback units will be distorted and the distortion of the composite video image can be seen by the viewer.

The allegation that the language "will be distorted and the distortion of the composite video image can be seen by the viewer" is intended use is clearly false. The Tracing Watermark Inserter 104a, 104b provides the functionality of imparting a prescribed transformation to the video image for warping the video image in a manner, and by an amount, not readily visible to a viewer such that a composite video image produced by multiple video playback units will be distorted and the distortion of the composite video image can be seen by the viewer. As such, the language is not an "intended use" as suggested by the Examiner, but rather, a limitation on

the means for imparting the prescribed transformation. The limitation clearly causes the means for transformation to be limited to those transformations which distort the composite video image and can be seen by the viewer. The limitation is in no way an intended use, because it does not in any way suggest how the video image will be used.

Moreover, the limitation does provide structure in that such additional functionality of the Tracing Watermark Inserter 104a, 104b represents the corresponding structure for "means for imparting" element.

Accordingly, as the Examiner has failed to show anywhere in the cited prior art where this means for imparting a prescribed transformation exists, Applicants submit that the rejection is without merit and accordingly respectfully request that the rejections over claims 19-30 and 62-77 be withdrawn.

Furthermore, Appellant stated that Chaum does not disclose warping by an amount not readily visible by a viewer, and in response thereto the Examiner states, "this is a subjective measure, since no specific quantitative measure is provided as to the amount of warping the examiner concludes that it is possible that the warping in Chaum's invention would be viewable." Again, Chaum does not disclose any amount of warping by an amount to not readily visible by a viewer, and Applicant disagrees with the Examiner that there is some undisclosed amount of warping imparted by Chaum. It is the Examiner's burden to show sufficient evidence that Chaum discloses warping by an amount not readily visible by a viewer; mere conjecture does not satisfy this burden.

As for the Official Notice, the Examiner takes Official Notice that certain functions are "common and well known in prior art in reference to watermarking protocols," and concludes that "it would have been obvious...to utilize a mathematical process to warp [an] image in order

to create a predictable signature." Assuming that the Examiner is correct in that certain functions are used in *watermarking protocols*, that fact alone does not make it obvious to use those same functions to "*warp an image* to create a predictable signature." Indeed none of the cited references disclose "warping the video image in a manner," such that at least two claim requirements are met: (i) "warping...by an amount, not readily visible to a viewer" and (ii) "such that a composite video image produced by multiple video playback units will be distorted and the distortion of the composite video image can be seen by the viewer." The mere fact that certain functions may exist for watermarking in no way makes it obvious to use those functions with a "prescribed transformation" to *warp the video image in the manner claimed.* Moreover, the Examiner has failed to show this relationship other than merely saying so. It is clear that the Examiner relies on inappropriate hindsight to arrive at the obviousness conclusion referenced above.

Moreover, with respect to the Official Notice of the various warping techniques in claims 20, 21 and 23-30, the Examiner has failed to provide any evidence as to the accuracy of his allegation. Rather, the Examiner has stated that the techniques are well known merely because he says so.

In addition, as is well known, in order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. As Rhoads (USP No. 6,363,159), Saito (USP No. 6,182,218), and Chaum fail to disclose the above cited limitations of claim 19, then based on the foregoing, it is submitted that Rhoads, alone or in combination with Saito and Chaum does not render claim 19-21, 23-30 and 62, or any claim dependent thereon obvious.

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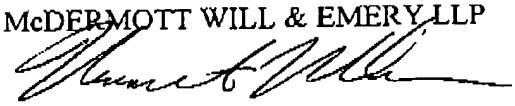
Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Harness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claims 19-21, 23-30 and 62 are patentable for the reasons set forth above, it is respectfully submitted that all pending dependent claims are also in condition for allowance.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



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